

**REMARKS**

Preliminarily, regarding the Restriction Requirement, Applicants affirm the election of claims 1-21.

Upon entry of this Amendment, 1-21 and 26-30 will be pending, of which claims 1, 2, 7, 9, 11, and 15 are independent. Claims 1-2, 7, 9, 11, and 15 have been amended to feature an equilibrium modulus of less than 1.2 MPa instead of the previous 1.5 MPa. Support for this revision can be found, e.g., on page 15, line 25, of the specification. Furthermore, some compositional features have been included in claims 1-2, 9, 11, and 15. Support for these features can be found, e.g., on page 16, lines 16-24, of the specification. Finally, new claims 26-30 have been added. Support for these new claims can be found, e.g., on page 20, lines 23-26 (claim 26); on page 21 lines 4-5 (claim 27); and on page 22, lines 10-23 (claims 28-30).

Claims 1-5, 7-13, and 15-21 stand rejected under 35 U.S.C. §112, second paragraph. Specifically, the Examiner contends that the claims are indefinite because they allegedly relate to a large number of products and methods. *See* paragraph 9 of the outstanding Office Action. First, Applicants note that several compositional and/or physical features have been added to the claims. Second, assuming, *in arguendo*, that the Examiner is correct in that the claims cover “a large number of products and methods”, that would still not negate the fact that the metes and bounds of all claims are clearly defined. Consequently, regardless of whether the claims cover a large number of products as the Examiner alleges, the claims are not indefinite and in full compliance with 35 U.S.C. §112, second paragraph. It is respectfully submitted that all claims are in full compliance with entire 35 U.S.C. §112 and withdrawal of the rejections under this statute is respectfully requested.

Claims 5, 13, 19, and 21 stand rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Aloisio *et al.* (U.S. 6,215,934). Furthermore, claims 5-6, 13-14, and 19 stand rejected as obvious over Chawla *et al.* (WO 97/42130). Applicants respectfully traverse these rejections for at least the following reasons.

Regarding Aloisio *et al.*, the Examiner appears to rely on “formulation D” in this reference. *See* paragraph 12 of the outstanding Office Action. In this regard, and as noted by the Examiner, formulation D has an equilibrium modulus of 189psi, which corresponds to 1.303 MPa (189/145). Accordingly, with the instant claims featuring moduli of 1.2 MPa or less, it is respectfully submitted that the rejections should be withdrawn.

Regarding Chawla *et al.*, the Examiner notes that this reference mentions ethoxylated bisphenol-A diacrylate and contends that “[a]ccording to applicant’s claimed invention a inner primary coating composition comprising a crosslinking component that introduces bimodal functionality into the composition should *inherently* produce a coated optical fiber and primary coating composition having an equilibrium modulus of about 1.5 or less, a storage modulus at 23<sup>0</sup>C, a cavitation strength at which a tenth cavitation appears ( $\sigma_{cav}^{10}$ ) of at least about 1.0 MPa as measured at a deformation rate of 0.20% min<sup>-1</sup> storage, and said cavitation strength being at least about 1.4 times said storage modulus at 23°C.” *See* paragraph 14 of the outstanding Office Action (emphasis added). In this regard, Applicants kindly ask the Examiner to point out where in the specification it is asserted that including bimodal functionality *inherently* results in the recited properties. Indeed, Applicants respectfully submit that the Examiner’s inherency argument is improper and withdrawal of the rejections is respectfully requested.

Application Serial No. 09/989,703  
Amendment filed December 13, 2003  
Page 11 of 11

For any and all of the above reasons, it is respectfully submitted that the present invention is patentable.

It is respectfully submitted that the present invention is in condition for allowance and a Notice to that effect is courteously solicited. However, if any questions remain, the Examiner is encouraged to contact the undersigned to expedite the prosecution of this application.

Respectfully submitted,  
PILLSBURY WINTHROP LLP

By



Paul L. Sharer  
Reg. No. 36,004  
Tel. No.: (703) 905-2180  
Fax No.: (703) 905-2500

PO Box 10500  
McLean, VA 22102  
(703) 905-2000